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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,103	04/13/2004	Rafael S. Lisitsa	228463	4522
45979	7590	10/03/2005		
PERKINS COLE LLP/MSFT P. O. BOX 1247 SEATTLE, WA 98111-1247			EXAMINER MYERS, PAUL R	
			ART UNIT	PAPER NUMBER

2112

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/823,103

Applicant(s)

LISITSA ET AL.

Examiner

Paul R. Myers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/13/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 4/13/04 have been fully considered but they are not persuasive.

In regards to applicants argument regarding the examiners motivation for combining references: The test of obviousness is:

"whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention," *In re Gorman*, 933 F.2d at 986, 18 USPQ 2d at 1888.

Subject matter is unpatentable under section 103 if it "'would have been obvious . . . to a person having ordinary skill in the art.' While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination." *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ 2d 1500, 1502 (Fed. Cir. 1988).

"Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same [or] similar problem which it addresses." *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979).

"In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found *in* a specific reference."

Entire quote from *In re Oetiker*, 24 USPQ 2d 1443 (CAFC 1992).

Accordingly, it is not required to disclose or specifically suggest particular elements. Instead the measure is what the teachings would suggest to one of ordinary skill in the art, not what the art specifically suggests.

In regards to applicants argument that Guo et al does not optimize at least one performance parameter: The examiner notes the claim language states performance parameters but is silent upon what these parameters are. It is clear that buffer size and service time are

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performance parameters and Guo et al Expressly teaches buffer size and service time are indexes and that selected indexes are optimized.

*Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guo et al PN 6,377,972 in view of Rexford et al PN 6,633,544.

In regards to claim 1: Guo et al teaches a method for connecting a plurality of streaming nodes (streaming multimedia) in a network environment (40) comprising the steps of: determining a set of connection constraints (Latency, Bandwidth, minimum required QOS, jitter, Distance between “helpers”, the number of hops between helpers, the activity of helpers, and the type of helpers, etc...); selecting at least one performance parameter (index such as buffer size and service time) to optimize (Column 18 lines 37-49); connecting the streaming nodes if the set of connection constraints is satisfied (Column 18 lines 50 to Column 19 line 33); and optimizing the at least one performance parameter (Column 18 lines 37-49). Guo et al does not teach maintaining the nodes in a graph. Rexford et al teaches using the well known Dijkstra’s algorithm to generate a shortest path graph of a streaming media network and optimizing the number of hops. It would have been obvious to a person of ordinary skill in the art for Guo et al to maintain the network in a graph because this would have allowed ease and speed in route

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computations in the network (see Rexford abstract) The examiner notes another well known graph algorithm such as the Floyd-Warshall algorithm or even the Bellman algorithm would have been just as obvious.

In regards to claim 3: Guo et al teaches connecting through proxy helpers (gateways) and minimizing the number of proxy helpers through which the data path is made.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 5, 6, 7 and 4 respectively of U.S. Patent No. 6,766,407. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claims only remove limitations from the patented claims.

***Allowable Subject Matter***

6. Claims 2, 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

1. The following is a statement of reasons for the indication of allowable subject matter: Guo et al teaches the use of the type of helpers for determining the path of data through the network, including gateway (proxy helpers). Guo et al however does not teach determining the path based upon the transform nodes available. The examiner was unable to find a reference that taught determining the path based upon the transforms available or trying to minimize the number of transforms available.

***Conclusion***

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Myers whose telephone number is 571 272 3639. The examiner can normally be reached on Mon-Thur 6:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rehana Perveen can be reached on 571-272-3676. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRM  
September 28, 2005

  
**PAUL R. MYERS**  
**PRIMARY EXAMINER**